

REMARKS/ARGUMENTS

Brief Summary of Status

Claims 1-83 are pending in the application.

Claims 1-83 are subject to restriction/election.

Restriction/election requirement

The Examiner asserts:

“1. This application contains claims 1-83 directed toward five patentably distinct species

Species I, figures 3- 5 - Cable TV class 725.105

Species II, figures 6a, 6b, 7a, 7b, 8, 9, 11 - Transcoder class 375/240

Species III, figures 7c-d - Bidirectional transcoder class 370/240.12, 240.26

Species IV, figure 10 - Transcoder processor class 375/240

Species V, figures 1, 2, 12 - Satellite communications class 725/63, 455/3.02;
342.35

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.” (non-final office action, Part of Paper No./Mail Date 20081008, p. 2, emphasis added)

The Applicant respectfully requests reconsideration of the election/restriction pursuant to 37 C.F.R. § 1.143, provides the reasons therefore below, and provisionally elects claims 1-29 and 68-83.

If the Examiner rejects the Applicant’s request for reconsideration, the Applicant requests that the Examiner make the election/restriction final so that the Applicant may petition the Director to review the requirement for election/restriction.

Moreover, a restriction of the claims based on the figures is inconsistent with 35 U.S.C. § 121, MPEP 806.04(e) and MPEP 2111. 35 U.S.C. § 121 states, in part, that “if two or more independent and distinct inventions are claimed in one application ...” MPEP 806.04(e) states, in part, that, “Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a

claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated *a generic or genus claim*). *Species are always the specifically different embodiments*". MPEP 2111 states, in part, that, "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that Applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim".

In particular, 35 U.S.C. § 121 and MPEP 806.04(e) indicate that if a restriction is applicable, it is the claims that are to be restricted, not the drawings. Further, the drawings are part of the specification, which, in accordance with MPEP 2111, may be used to interpret limitations explicitly recited in the claims, but not to provide limitations of the specification into the claims. Utilizing the figures to restrict the claims corresponds to providing limitations of the specification into the claims, which is not permitted by MPEP 2111. Accordingly, the restriction based on the figures is inappropriate and should therefore be withdrawn.

The Applicant respectfully points out that the Applicant's independent claim 1 is supported by at least FIG. 6A, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claim 16 is supported by at least FIG. 6B, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claim 23 is supported by at least FIG. 6B, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claims 30, 35, 40, 47, 54, and 61 are supported by at least FIG. 9, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claim 68 is supported by at least FIG. 6A and FIG. 11, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claim 76 is supported by at least FIG. 6B, which the Examiner associates with Species II.

The Applicant respectfully points out that the Applicant's independent claim 80 is supported by at least FIG. 6B, which the Examiner associates with Species II.

As such, the Applicant respectfully asserts that all of the Applicant's independent claims 1, 16, 23, 30, 35, 40, 47, 54, 61, 68, 76, and 80 are supported at least by the Applicant's Figures that the Examiner associates with Species II in the office action.

Moreover, the Applicant respectfully asserts that each of the corresponding dependent claims, further limiting the subject matter as claimed in each of the respective independent claims 1, 16, 23, 30, 35, 40, 47, 54, 61, 68, 76, and 80, are also supported by the Applicant's Figures that the Examiner associates with Species II in the office action.

35 U.S.C. § 112, fourth paragraph, states, in part, "a claim in dependent form shall contain ... a further limitation of the subject matter claimed ... [and] shall be construed to incorporate by reference all the limitations of the claim to which it refers". As such, each dependent claim and its corresponding independent claim herein provide varying breadth and/or scope of definition of the at least one disclosed embodiment.

MPEP 806.03 states, in part, "where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction there between should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition". Accordingly, a dependent claim that is a further limitation of the subject matter claimed in a corresponding independent claim should not be subject to restriction since they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Again, the Applicant provisionally elects claims 1-29 and 68-83 that are all supported by the Applicant's Figures that the Examiner associates with Species II in the office action.

The Applicant respectfully reserves the right to present any non-provisionally-elected, non-elected, withdrawn, and/or canceled claims in a subsequent filing that may include a divisional patent application, and/or another patent application type, which may claim priority to the present U.S. utility patent application.

Also, in view of the Examiner's comments within the office action (i.e., "independent or distinct", "not obvious variants of each other", "mutually exclusive

characteristics”), the Applicant respectfully believes that claims within each of the other Examiner-identified inventions/Species should **never** be a basis for a subsequent provisional or non-provisional statutory and/or non-statutory double patenting rejection for any claims within the Applicant-provisionally elected and Examiner-identified Species II, and vice versa, that may be submitted in a separate filing that may include a divisional patent application, and/or another patent application type, which may claim priority to the present U.S. utility patent application.

The Applicant respectfully believes that no fees are due.

The Applicant respectfully believes that claims 1-83 are in condition for allowance and respectfully requests that they be passed to allowance.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present U.S. utility patent application.

RESPECTFULLY SUBMITTED,
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